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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/497,123	02/03/2000	Dominique D. Messerli	8932-114	7121

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EXAMINER

PELLEGRINO, BRIAN E

ART UNIT	PAPER NUMBER
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3738

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DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/497,123

Applicant(s)

MESSERLI ET AL.

Examiner

Brian E Pellegrino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,7,9,14,15,19 and 25-64 is/are pending in the application.
- 4a) Of the above claim(s) 30,31,33,34,37,38,49,50,52,53,56 and 57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,7,9,14,15,19,25-29,32,35,36,39-48,51,54,55 and 58-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 February 2000 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 11/25/03 has been entered.

Election/Restrictions

Claims 37,38,56,57 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species (Specie F), there being no allowable generic or linking claim. Additionally, claims 30,31,33,34,49,50,52,53 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species (Specie E), there being no allowable generic or linking claim.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "implant consisting

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of **two** end members” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the specification failed to provide support for the use of **two** end members with an implant. Additionally, the written disclosure does not describe the top surface as having no through holes. Also, “a *dimension* of the longitudinal axis *being identical* to a dimension of the lateral axis” was not found in the specification. Also not found, “a *dimension* of the major axis *being larger* than a dimension of the minor axis”. There is also no antecedent basis for “outer cross-sectional dimensions” for the “spacer body” and “first portion of the end member” being “identical when the second portion of the end member is inserted”. Applicant has failed to specifically point out the support in the original disclosure for each of the newly presented claim limitations as cited above (M.P.E.P. 714.02). Because of the procedure outlined in M.P.E.P. 2163.06 for interpreting the claims, it is noted that other art may be applicable under 35 U.S.C. 102 or 35 U.S.C. 103(a) once the aforementioned problem potentially under 35 U.S.C. 112,

first paragraph, is corrected. Careful consideration must be taken so as to not add new matter to the disclosure.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,2,4,7,9,14,15,19,25-29,32,35,36,39-48,51,54,55,58-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rabbe et al. '197 in view of Zucherman et al. (WO 98/29047). Fig. 3 shows an end member **22** having a first portion **35** and a second portion **37**. The first portion 35 can be interpreted as a shoulder since it extends beyond the second portion. Since claims are to be interpreted in light of the specification, which includes the drawings {note Applicant's drawing (Fig. 9) illustrates the shoulder is integral with the first portion}. The shoulder portion is fully capable of being sized to rest on an edge of an implant. Rabbe et al. also disclose two channels **47** which are opposite one another on an annular, solid top portion. Additionally, the top surface has a plurality of two-dimensional teeth **120**, which are spaced apart from one another, see Fig. 7. Rabbe additionally discloses that the "end member" can be sized to place in an implant or reverse the threading, col. 7, lines 12-16. However, Rabbe fails to disclose the second portion of the end member to include a plurality of resilient tabs to secure with the implant. Zucherman et al. teach the use of a plurality of resilient tabs to secure an end member with a cylindrical implant member, Fig. 73. Zucherman also teach the tabs or "arms or hooks" are resilient or "springy", page 30, lines 21-24. It

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would have been obvious to one of ordinary skill in the art to substitute fastening means and use the resilient tabs or arms as taught by Zucherman et al. with the implant and incorporate them with the end member of Rabbe such that the end member is easier to insert in the implant and provides the ability to secure together the components.

Regarding claims 7,43 Rabbe discloses the end member can have a different shape or one that is more rounded, col. 7, lines 59-61. It would have been an obvious matter of design choice to modify the shape of the end member, since applicant has not disclosed that using an oval shape provides any advantage, or solves a stated problem, or is used for any particular purpose. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the rounded end member as taught by Rabbe or the claimed oval shape in claim(s) 7,43 because both end members perform the same function of being able to engage bone.

Regarding claims 15,32,35,36,45,51,54,55 it would have been an obvious matter of design choice to modify the shape of the end member, since applicant has not disclosed that using anterolateral or offset channels provide any advantage, or solve a stated problem, or are used for any particular purpose. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the channel positions taught by Rabbe or the claimed anterolateral or offset channels in claim(s) 15,32,35,36,45,51,54,55 because both end members perform the same function of being able to receive a surgical instrument.

Regarding claims 19,46 Zucherman et al. teach the materials for the implant can be made of metal, page 8, lines 3,4. It would have been obvious to one of ordinary skill

in the art to substitute metal as taught by Zucherman et al. for the end member of Rabbe in order to provide enhanced radiopacity in implantation procedures using imaging devices.

With respect to claims 27,42,63 it can be seen (Fig. 3) that Rabbe discloses two end members and a spacer positioned there between.

Regarding claims 28,47 it would have been an obvious matter of design choice to modify the top surface and have no through holes, since applicant has not disclosed that eliminating through holes provides any advantage, or solves a stated problem, or is used for any particular purpose. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the top surface of the end member as taught by Rabbe or the claimed top surface without through holes in claim(s) 28,47 because both top surfaces perform the same function of providing an edge to form a shoulder to rest on the implant and also have an area for teeth.

With respect to claims 39,58 it would have been an obvious matter of design choice to modify the number of tabs used, since applicant has not disclosed that using four tabs provides any advantage, or solves a stated problem, or is used for any particular purpose. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the number of tabs or arms taught by Zucherman in modifying the Rabbe end member or the claimed four tabs in claim(s) 39,58 because both end members with tabs perform the same function of being secured in the implant.

Respons to Arguments

Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Pellegrino whose telephone number is (703) 306-5899. The examiner can normally be reached Monday-Thursday between 9:00 A.M. and 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (703) 308-2111. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Brian E. Pellegrino

TC 3700, AU 3738

Brian E. Pellegrino